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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,086	12/11/2000	Charles Tresser	YOR920000598US1(13893)	3901

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EXAMINER

DASS, HARISH T

ART UNIT PAPER NUMBER

3628

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/734,086

Applicant(s)

TRESSER ET AL.

Examiner

Harish T Dass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 5, 7-8, 11, 13-14, 17, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leighton et al (hereinafter Leighton – US 5,351,302) in view of Smithies et al (hereinafter Smithies – US 6,091,835).

Re. Claims 1, 7 and 13, Leighton substantially discloses the limitations of current application such as: creating digitally secure document using cryptography, concatenation of data strings, digital signature, etc [see the entire document particularly, Abstract; C1 L1 to C2 L16], an owner, creating titles for personal and real property, the title including (i) a message describing the title and how to contact the owner, and (ii) a digital signature of the owner [C1 L35-L68], the owner transferring ownership of the financial instrument to another person, including the steps of i) the owner appending to the title a public part of a signature scheme of said other person [C2 L51-L68], and ii) the owner signing the title using a public signature scheme of the owner [C2 L51-L68]. Leighton does not explicitly disclose creating a title for a financial instrument. However, Smithies discloses this step [see entire document particularly, Abstract; Figures 1-2, 4d-4g; C2 L5-L63; C3 L39-L61; C4 L29-L47; C7 L42 to C10 L20; see negotiable

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instrument] to create a more broad base computer system for gathering and recording information concerning the affirmation of an electronic document. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Leighton and include creating a title for a financial instrument (negotiable instrument), as disclosed by Smithies, to generate a comprehensive record of fact associated with electronic document.

Re. Claims 2, 8 & 14 Leighton discloses wherein the transferring step includes the step of appending to the title a number indicating the number of successive owners of the title (ownership history) [C5 L13-L44].

Re. Claims 5, 11, & 17 Leighton discloses wherein, the creating step includes the step of using a secure cryptographic generator to create the title [C1 L35-L45; C3 L31 to C4 L14].

Re. Claim 19, Leighton discloses said signature scheme includes a private key and a public key; and the step of the owner signing the title includes the step of the owner using the public key of the signature scheme to encrypt the owner's signatures in the title [C1 L54 to C2 L16].

Re. Claim 20, Leighton discloses appending to the title a number indicating the number of successive owners of the title; and said other person using said private key of the

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signature scheme to decrypt the owner's signatures and said number [C1 L54 to C2 L16; C2 L28-68; C4 L26-L68].

Claim 3-4, 9-10 & 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leighton and Smithies as applied to claims 1, 7, 13 above, and further in view of Muftic (US 5,850,442).

Re. Claims 3-4, 9-10 & 15-16 Leighton discloses creating digital secure encrypted document (titles) using "public-key cryptosystem" [C1 L1 to C2 L16; C3 L31 to C4 L14]. Leighton or Smithies does not explicitly disclose owner keeping the public part of the signature of the other person and making said public part available to potential subsequent buyers and comprising the step of sending the title, with the signature of the owner made using the public signature scheme of the owner, to said other person. However, Muftic discloses these steps [Abstract, Figures 17, 25-27; C1 L32 to C8 L7; C7 L32-L63; C7 L1-L5; C18 L35-L67] to conduct secure electronic commercial transaction over the network, which uses public key cryptography. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Leighton, Smithies and Muftic to permit secure transaction to undertake world wide transparently over the Internet.

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Claims 6, 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leighton and Smithies as applied to claims 5, 11, 17 above, and further in view of Arbaugh et al (US 6,185,678).

Re. Claims 6, 12 & 18 Leighton or Smithies does not explicitly disclose wherein the secure cryptographic generator is an IBM 4758. However, Arbaugh et al discloses this step to allow software and data to be transferred between computer system [C1 L20-67; C4 L33-L65; C7 L6-L27; C9 L11-60]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Leighton, Smithies and Arbaugh et al to permit secure transaction to undertake over the Internet.

### ***Response to Arguments***

2. Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR ' 1.111 (c) to consider the references fully when responding to this action.

*(Previously submitted) US 6,711,554 to Salzmann et al,*

*(New) Whitaker, Nov, 1999 ""Rules under the Uniform Electronic Transactions*

*Act for an electronic equivalent to a negotiable promissory note. (Survey of the Law of*

*Cyberspace)" discloses electronic signature as replacement for manual signature, transferring rights and electronic records substitute for negotiable documents.*

*US 6,076,064 to Rose Jr., Jun. 13, 2000 "Uniform system for verifying and tracking the title of articles or objects of value " discloses a data processing methodology and apparatus for effecting a universal, uniform system for tracking transactions for tangible and intangible items objects or of value, such as motor vehicles, boats, antiques, artwork, and real property, it relates to a computerized system by which all current systems are converted in a uniform manner to a unique but universal system, by creating and then centralizing, that single system as the single source of the tracking system so that data may be input from a variety of sources and accurate, up-to-date titles and registrations may be created and issued in a congruent and continual manner.*

*US 5,899,978 to Irwin, May 4, 1999 "Titling System and Method Therefor" discloses title transferring method that includes security measures and document tracking features. Enables batch processing of large number of documents and fee payments associated with common jurisdiction. Enables the title transferring method to efficiently process title work, registration licenses related to large number of products.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T Dass whose telephone number is 703-305-4694. The examiner can normally be reached on 8:00 AM to 4:50 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S Souh can be reached on 703-308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass  
Examiner  
Art Unit 3628

10/16/04

  
HYUNG SOUGH  
SUPERVISORY PATENT EXAMINER  
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